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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/836,734	07/02/1997	JACQUES BECKMANN	960-29	6656

7590 04/24/2002

NIXON & VANDERHYE
1100 NORTH GLEBE ROAD
8TH FLOOR
ARLINGTON, VA 222014714

EXAMINER

ZITOMER, STEPHANIE W

ART UNIT	PAPER NUMBER
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1634

DATE MAILED: 04/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/836,734

Applicant(s)

BECKMANN ET AL.

Examiner

Stephanie Zitomer

Art Unit

1634

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) 1-22 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1634

RESTRICTION

Response to election and traversal

1. Applicant's election with traverse of Group I, claims 1-4, 8 and 20 in Paper No. 10 filed April 27, 1998 is acknowledged. The traversal is on the ground(s) that "a complete search of the subject matter of Group I would include the subject matter of group III and thus no undue burden would be placed on the examiner if the claims of at least these two Groups were to be considered in the same application". This is not found persuasive because the statement is conclusory in that no evidence or explanation has been given to support it. Therefore, the requirement for restriction to elected Group I is still deemed proper and is made FINAL. Nonelected claims 4-7 and 9-19 have been withdrawn from prosecution.

Elected claims

2. Applicant's election of Group I effectively elects in claim 20 the nucleic acid sequence of claim 1 and the host cell according to claim 8. Therefore, claim 20 c), drawn to the amino acid sequence of claim 5, has been withdrawn from allowance.

Restriction to one nucleotide sequence in elected Group I

3. Claims 1-4, 8 and 20 of elected Group I comprise multiple distinct inventions defined by multiple nucleotide sequences, *viz.*, SEQ ID NOS:1-4, 5, 68 and 69. Applicant is required to elect **one** invention, *i.e.*, **one** sequence to which prosecution of the elected claims will be restricted.

4. Nucleotide sequences encoding different proteins are structurally and functionally distinct chemical compounds unrelated to one another as are the proteins they encode. Absent evidence to the contrary, these sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Pursuant to this statute, the rules provide that "[i]f two or more independent and distinct inventions are claimed in a single application, the examiner in his action shall require the applicant . . . to elect that invention to which his claims shall be restricted." 37 CFR 1.142(a). See also 37 CFR 1.141(a).

Art Unit: 1634

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. A telephone call was made to Mary Wilson on April 3, 2002 to request an oral election to the above restriction requirement, but did not result in an election being made.

Contact information

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephanie Zitomer whose telephone number is (703) 308-3985. The examiner can normally be reached on Monday through Friday from 9:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones, can be reached on (703) 308-1152. The official fax phone number for this Group is (703) 308-4242. The unofficial fax number is (703) 308-8724. The examiner's Rightfax number is 703-746-3148.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196. For questions and requests relating to formal matters contact Patent Analyst Tiffany Tabb at 703-605-1238.

S. Zitomer
Stephanie Zitomer, Ph.D.

April 22, 2002